

REMARKS**Unity of Invention**

Claims 1-49 are pending and are subject to a Unity of Invention restriction under 35 U.S.C. §§ 121 and 372 for reciting inventions or groups of inventions that are not so linked as to form a single general inventive concept under PCT Rule 13.1. (*See*, Office Communication of June 22, 2007, at page 2, hereinafter “Office Communication”). Applicants traverse as herein after set forth.

For the purpose of examination of the present application, Applicants elect, with traverse, Group XII, Claims 19, 20, 21, 22 and 23.

Applicants traverse the Unity of Invention restriction at least on the grounds that a) the Examiner has not sufficiently set forth the reasoning behind the restriction, b) the Examiner’s restriction is improper because in fact, the claims should, at most, be subject to a species election, not a restriction, and c) it would not be an undue burden to examine the claims as presented.

First, Applicants point out that the Examiner provides only very limited reasoning for the extreme restriction of the claims into 25 groups. The Examiner does not explain, for instance, the reason for restriction between all of groups XIV-XXV. The Examiner merely provides a cursory conclusion that these groups are directed to different methods. The Examiner groups several claims into multiple groups without any explanation. Groups VIII-XII are all drawn to the same subject matter, all being described simply as being “drawn to a cell.” No further

explanation is provided that would allow Applicants to even distinguish the subject matter between these groups.

In short, the restriction appears to be random and arbitrary. Very little explanation is provided for many of the groups and that which is provided is cursory, providing no support or reasoning. Thus, Applicants insist that the Examiner has failed to meet the burden required to impose such a unity of invention restriction requirement.

The Examiner even fails to acknowledge that if Applicants chose to pursue claims directed to a composition, Applicants are entitled to rejoinder of otherwise allowable method claims dependent from an allowed composition claim. The Examiner is reminded that because the present Restriction is between a product and its process of use, where Applicants elect claims directed to the product, and a product is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claims will be rejoined in accordance with the provisions of M.P.E.P. § 821.04. Such process claims that depend from or otherwise include all the limitations of the patentable product are entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Furthermore, in the event of rejoinder, Applicants understand that the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims must be fully examined for patentability according to the provisions of 37 C.F.R. § 1.104.

According to MPEP § 1893.03(d), the Examiner is respectfully reminded that if the Examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable, the

nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. (*See*, MPEP § 821.04 and § 821.04(a)). Any nonelected processes of making and/or using an allowable product should be considered for rejoinder following the practice set forth in MPEP § 821.04(b).

Second, Applicants insist there should be no restriction at all between different composition claims or between different method claims. Applicants should, at most, only be required to select an initial species for examination. Once allowable subject matter is identified concerning the initially selected species, the Examiner should then proceed to consider other species. For instance, at least claims 13-23 should be properly placed in the same group.

Additionally, claims 26-40 should be rejoined into a single group because all of these claims have in common a single general inventive concept or special technical feature. In fact, this must be true because many of the claims are interdependent. Thus, the lack of any explanation for the restriction of these claims coupled with their interdependence and common special technical feature must cause the Examiner to reconsider this restriction.

It is noted that most of the groups listed at pages 2-3 of the Office Communication appear to be arbitrary, with no distinguishing features provided by the Examiner between the groups and no explanation provided by the Examiner that could possibly form the basis of such a restriction requirement.

Finally, Applicants insist that their claims are linked by a special technical feature and that the Examiner has not provided any basis or evidence refuting this claim. Thus, there being

no prior art which could possibly destroy this special technical feature, the Examiner's restriction requirement remains without support or evidence.

Third, according to MPEP § 803, if the search and examination of an entire application can be made without a serious burden, the Examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions. As further evidence of the Examiner's failure to properly consider the claimed subject matter and provide support for the imposed restriction requirement, it is noted that the Examiner has failed to list any classes or subclasses that must be searched for the different Groups.

It certainly is not an undue burden upon the Examiner to consider all of claims 13-23 since they are all directed to a cell. This same argument may be applied also to claims 26-40 since they are drawn to a commonly linked method/process of use.

Therefore, for at least these reasons, Applicants assert that the Examiner has entirely failed to establish the need for a restriction because there is no evidence or reasoning provided for the assertion that there is no common special technical feature and/or no common general inventive concept.

For at least the preceding reasons, Applicants respectfully request that the unity of invention restriction be reconsidered and withdrawn.


CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Thomas J. Siepmann, Ph.D., Registration No 57,374 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 
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